

### Remarks

Applicant have carefully considered the Office Action dated May 20, 2005 and the references cited therein. Applicant respectfully requests reexamination and reconsideration of the application.

Claims 2-6, 9-10, 15-18 stand rejected under 35 USC Section 103(a) as being unpatentable over United States Patent 5, 706,449, Liu et al., hereafter referred to Liu, already of record, and newly cited published United States Patent application 2002/0045887 A1, DeHoogh et al., hereafter referred to DeHoogh. In setting forth the rejections, the Office Action has expressly admitted that Liu does not teach a directional command identifying a relative direction of a position of the second displayed data item to a position of the first displayed data item. Instead, the Examiner is relying on DeHoogh alleging that such feature is well-known in the art and that DeHoogh teaches that after a user depresses Swap button 112 on the touch screen, the system receives data defining the position of an icon to the data item. The Office Action further alleges that it would have been obvious to one of ordinary skill in the art, having the teachings of Liu and DeHoogh before him at the time the invention was made, to modify the interface method taught by Liu to include the generating directional icons taught by DeHoogh with the motivation being to enable the user to quickly and conveniently enter commands.

Applicant respectfully traverse the above rejection. The Examiner has failed to create a *prima facie* case of obviousness on the grounds that the combination of Liu and DeHoogh does not teach or suggest the claim limitation of "a *directional command identifying a relative direction* of a position of the second displayed data item to a position of the first displayed data item" (claim 2, lines 6-8; see also claim, 9 lines 8-10; claim 15, lines 7-9). Applicants respectfully assert that DeHoogh does not teach, disclose or suggest the admitted deficiencies of Lui. DeHoogh discloses a method of mapping surgical functions of the microsurgical system to a foot controller operatively coupled with the system. The microsurgical system includes a touch screen display has the ability to display a graphic representation of the foot controller including the plurality of

switches, and to display a list of surgical functions so that the list is associated with the graphical representation of one of the plurality of switches. (US Publication No. 2002/0045887 A1; Abstract). The Examiner will note that map switches 56a, 56b, 58a, 58b, 60 and 62 are not user selectable directional commands in a graphical user interface but are merely graphic representations of switches within foot controller 26 (US Publication No. 2002/0045887 A1; Paragraph 28; Fig. 4), as further corroborated by the absence of any "Up" arrow graphic representations in screen 100. As illustrated in Figure 8 of Dehoogh, a user may access a list of functions 120 by touching pulldown menu arrows 106 associated with one of the switches. However, such directional up and down commands can only be used for scrolling through the list of surgical functions 120 associated with a switch (US Publication No. 2002/0045887 A1; Paragraph 35-36). In DeHoogh, the process by which a user can exchange the functions of any two binary switches on foot controller 26 is outlined below:

The various functions of list 120 can be accessed via a user touching scroll down arrow 110 or scroll up arrow 112, as is conventional. Using list 120, a user can exchange the functions of any two binary switches on foot controller 26. For example, if a user were to touch the Next Mode function in list 120 associated with switch 58a, the Alternate Infusion/Irrigation function would be assigned to left heel switch 60, and the Next Mode function would be assigned to right vertical switch 58a, as shown in FIG. 9. Although not shown in FIG. 8, a user may access a list of functions 120 by touching pull down menu arrow 106 associated with any of switches 56a, 56b, 58b, 60, or 62. In this manner, a surgeon, or his or her nurse, may map any of the functions of microsurgical system 10 or its associated handpieces that are capable of being controlled by foot controller 26 to any of the binary switches 56a, 56b, 58a, 58b, 60, or 62 of controller 26.

(US Publication No. 2002/0045887; Paragraph 35)

Once the desired mapping of switches 56a, 56b, 58a, 58b, 60, and 62 is accomplished, the user again presses Swap button 112.

(US Publication No. 2002/0045887; Paragraph 36)

Menu arrows 106 associated with a first switch *can not* be used to identify another of the switches or its surgical functionality with which another selected

functionality will be swapped. There is no directional demand involved in the swapping process. The switch selection for the swapping process is determined by which switch currently is assigned to the desired function. In DeHoogh, if the Examiner is analogizing a first switch and its associated function with the first displayed data item recited in claim 1, and a second switch and its associated function with the second displayed data item also recited in claim 1, then the Examiner has not shown where DeHoogh discloses, presumably using with menu arrows 106, a technique for *receiving through the user interface a directional command identifying a relative direction of a position of the second displayed data item to a position of the first displayed data item*. In DeHoogh, menu arrows 106 associated with one switch *can not* be used to identify the relative direction of the other switch. This is corroborated by the absence of any “Left” or “Right” menu arrows 106 associated with a switch’s function list 120. As such, in DeHoogh, the swapping of functions between two switches is not controlled with a directional command identifying *a relative direction of a position of the second displayed data item (second switch) to a position of the first displayed data item (first switch)*.

In light of the above, Applicant respectfully asserts that even if the teachings of Liu and DeHoogh are properly combinable, which Applicant is not admitting to, the combination of Liu and DeHoogh does not teach or suggest the claim limitation of “a directional command identifying *a relative direction of a position of the second displayed data item to a position of the first displayed data item*” (claim 2, lines 6-8; see also claim 9, lines 8-10; claim 15, lines 7-9).

Applicant further respectfully traverses the above rejection of the grounds that the Examiner has failed to show where in either reference there is some suggestion or motivation either to modify Liu with the teachings of DeHoogh, or, to combine the Lui and DeHoogh references, and, further, that there can be no expectation of success in the combination of Liu and DeHoogh because neither reference includes a teaching, suggestion or motivation as to how these disparate technologies would be combined to accomplish the subject matter as

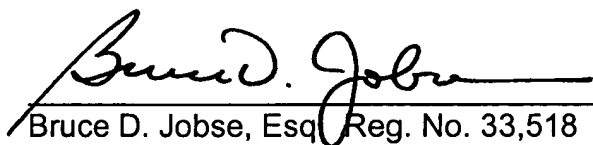
claimed. How would the menu arrows 106 of DeHoogh be integrated into and provide the required teachings missing from the interface of Liu?

Applicant respectfully reasserts all of the remarks and traversals set forth in prior responses to the extent still relevant to the outstanding rejections.

If after considering the above remarks and amendments, the Examiner is still not of the opinion that allowable subject matter is claimed, Applicant respectfully requests a telephone interview with the Examiner and his/her respective Supervisory Patent Examiner to resolve any outstanding issues prior to issuance of any further office actions.

Applicant believes the claims are in allowable condition. A notice of allowance for this application is solicited earnestly. If the Examiner has any further questions regarding this amendment, he/she is invited to call Applicant's attorney at the number listed below. The Examiner is hereby authorized to charge any fees or credit any balances under 37 CFR §1.17, and 1.16 to Deposit Account No. DA-12-2158.

Respectfully submitted,



Date: 8/22/05

Bruce D. Jobse, Esq. Reg. No. 33,518  
KUDIRKA & JOBSE, LLP  
Customer Number 021127  
Tel: (617) 367-4600 Fax: (617) 367-4656